

REMARKS/ARGUMENTS

Reconsideration and re-examination are hereby requested.

Claim 9 has been amended to correct informalities pointed out by the Examiner.

The Examiner has indicated that the Declaration under 37 CFR 131 presented with the response to the last office action failed to overcome Kodama (U. S. Patent Application Publication: US 2003/0160197) as a reference.

Applicant wishes to make of record a telephone interview with the Examiner on November 16, 2006. The Examiner has filed an interview summary. Applicant wishes to clarify the examiner's summary by pointing out that the last statement should more accurately state that applicant's attorney pointed out that all test data was for a 1:1 model because the inventors decided to first build a 1:1 model and that a model with a different area size ratio had not been competed before the filing date of the subject patent application.

It is Applicant's position that the Exhibits show conception of the claimed subject matter (i.e., "the first wall portion having a greater surface area than the surface of the second wall portion") in claims 1, 4, 9 and 12 prior to the effective date (Feb. 4, 2003) of the Kodema reference. It is also Applicant's position that the Exhibits show diligence from a time prior to the effective date (Feb. 4, 2003) of the Kodema reference until the constructive reduction to practice of the invention i.e., until the filing date of the subject patent application on January 21, 2006.

Applicant submits herewith a Supplemental Declaration.

Applicant respectfully requests the Examiner to answer the following questions:

1. Have the declarations, particularly Exhibit A, shown conception of the invention set forth in claims 1, 4, 9 and 12 prior to February 4, 2003;
2. Does the Examiner belief the statements by the inventors that, as stated in paragraph D in the Supplemental Declaration:

.. it was, as an **initial first step** in reducing the electronic valve actuator having a fluid-containing chamber; a first piston providing a first wall portion of the chamber; and a second piston providing a second wall portion of the chamber, the first wall portion having a greater surface area than the surface area of the second wall portion to initially **fabricate** the valve shown in Figure 3 of Exhibit A with the two pistons forming portions of the walls

of the chamber having the equal surface areas (i.e., a 1:1 ratio device). More particularly, we chose to make a 1: 1 ratio device as a matter of convenience because it allowed us to utilize our pre-existing hardware and supporting test fixtures. Although this prototype was realized at 1:1, ALL of our modeling and analysis documentation was focused on characterizing behavior on ratios greater than 1:1. For our purposes, the real value of hardware is to validate the relationships being modeled and the 1:1 hardware was convenient for that purpose (confirm leakage 1 tolerance / viscous relationships, etc.). We then rely on the models to allow us to predict behavior at the ratio condition other than 1:1 (e.g., the electronic valve actuator a fluid-containing chamber having a first piston providing a first wall portion of the chamber; and a second piston providing a second wall portion of the chamber, the first wall portion having a greater surface area than the surface area of the second wall portion) that is most appropriate for a given application, package space, etc.

3. Point out a hiatus in the Exhibits filed with the Declaration and Supplemental Declaration failing to show diligence in first reducing a 1:1 ratio device to practice from about January 01, 2003 until the filing of the patent application?

4. Please advise whether because applicant first decided to initially fabricate a device having a 1:1 ratio applicant is precluded from showing diligence towards reduction to practice of a device having a ratio other than a 1:1 piston area ratio.

5. Please advise whether because applicant first decided to initially fabricate a device having a 1:1 ratio applicant is precluded from showing diligence towards reduction to practice of a device having a ratio other than a 1:1 piston area ratio even though, as stated by the Applicant's in the Declaration previously filed in the accompanying Supplemental Declaration:

" ...ALL of our modeling and analysis documentation was focused on characterizing behavior on ratios greater than 1:1."

In view of the foregoing, it is Applicant's position that the Exhibits show conception of the claimed subject matter in claims 1, 4, 9 and 12 prior to the effective date of the Kodema reference and also show diligence from the time prior to the effective date of the Kodema reference until the filing date of the subject patent application.

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Reply to Final Rejection of October 3, 2006

Therefore, reconsideration of the Declaration and Supplemental is respectfully requested.

In the event any additional fee is required, please charge such amount to Patent and Trademark Office Deposit Account No. 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No. 06-1505.

Respectfully submitted,

January 29, 2007

Date

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